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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,759	09/12/2003	Andrea Liebmann-Vinson	P-5843	5974
46851	7590	08/24/2006	EXAMINER	
DAVID W. HIGGET BECTON, DICKINSON AND COMPANY 1 BECTON DRIVE, MC110 FRANKLIN LAKES, NJ 07417				SRIVASTAVA, KAILASH C
			ART UNIT	PAPER NUMBER
			1655	

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/660,759	LIEBMANN-VINSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dr. Kailash C. Srivastava	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 June 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 20-27 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) \_\_\_\_\_ is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) 20-27 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                          |                                                                             |
|--------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                         | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .                                              |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                          | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

1. Applicant's response filed 14 June 2006 to Office Action mailed 14 March 2006 is acknowledged and entered.
  
2. Examiner very much appreciates that the applicants label each page of the response referred above with Attorney Docket Number and Serial Number of the Non-Provisional U.S. Application currently under prosecution at the United States Patent and Trademark Office (i.e., USPTO). This practice in itself immensely ameliorates the chances of papers lost during transaction/transmission of paper once a filing/response arrives at the United States Patent and Trademark Office (i.e., USPTO). However, after a response/filing arrives at the USPTO, the claims, remarks, amendments etc., are separated for proper coding to scan them in the electronic file wrapper (i.e., IFW). In order to ensure that all the papers pertaining to a particular application are properly coded and placed in the same application electronic file wrapper, and to further facilitate the prosecution; especially during a telephonic conversation/ interview with applicant/applicants' representative, Examiner suggests that applicants recite in the header of the each page for any filing/response/amendment, the following information:
  - a. Filing date for said application;
  - b. First Applicant's name;
  - c. Group Art Unit Number (e.g., 1655);
  - d. Examiner's name (e.g., Dr. Kailash C. Srivastava);
  - e. Date of the Office Action to which response is being filed (e.g., 2 August 2006); and
  - f. Filing date of amendment/response (e.g., 31 August 2006).

Papers/responses filed according to above-stated guidelines immensely ameliorate the chances of papers lost during transaction/transmission, coding, indexing and placing the papers in IFW.

### Claims Status

3. Claims 1-19 have been cancelled.
  
4. Claims 21-27 have been added.

5. Claim 21 has been amended.
6. Claims 21-27 are pending and are examined on merits.

### **Restriction/Election**

7. Applicants' election without traverse of Group IV encompassing Claim 20 filed 14 June 2006 to Office Action mailed 14 March 2006 is acknowledged and entered. Since the election is made without traverse, the restriction requirement is deemed proper and is made FINAL.
8. Upon further review of the elected claim and in view of the applicant's arguments that newly added Claims 21-27 depend from amended "Claim 20 and recite various embodiments of the elected invention", the elected Claim 20 and newly added Claims 21-27 depending from Claim 20 are put together in Group IV of the election/restriction requirement in Office Action mailed 14 March 2006 and said election/restriction is re-formulated as follows:

### **Election of Species**

9. This application contains claims directed to the following patentably distinct types of species.
  - i. Category A – reactive group consisting of a carboxyl, an amine, an amino, an acyl, an ester, an epoxy, a silane, a silanol, an aldehyde, and a sulfhydryl according to Claim 21;
  - ii. Category B–Cell adhesive molecule selected from a protein, a protein fragment, a polypeptide, an oligopeptide, an amino acid, a proteoglycan, a glycoprotein, a lipoprotein, a carbohydrate, as disaccharide, a polysaccharide, a nucleic acid, an oligosaccharide, a polynucleotide, a synthetic polymer, a natural polymer and combinations thereof according to Claim 26;
  - iii. Category C- at least one cell adhesive molecule is from the group consisting of an extracellular matrix molecule, a growth factor and an antibody according to Claim 27.

Each of the components encompassed in Categories A-C respectively are distinct to each other within a given category and between the three categories because each embodies a different structure and property than the other with no recited common property.

A search over all possibilities will be at a minimum a factorial of 29\*28, 29\*27, 29\*26, 29\*25, 29\*24.... 29\*1, which together with other embodiments in Claims 20, 22-25 would generate combinations of geometrical proportions and would be burdensome. The search would also be burdensome because on each member within a species category cited above there is extensive non-coextensive scientific and technical literature.

Applicants are therefore, required under 35 U.S.C. §121 to elect a single disclosed species from each category cited above, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

For example, applicants election of species may be stated as, "applicants elect for prosecution, amine as the reactive group, proteoglycan as cell adhesive molecule and an antibody as another cell adhesive molecule from Claim 27".

10. Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable, or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR §1.141. If claims are added after the election, applicants must indicate which are readable upon the elected species [MPEP §809.02(a)].

Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103(a) of the other invention.

11. Applicants are advised that the reply to this requirement to be complete must include an election of the species to be examined even though the requirement is traversed (37 CFR §1.143).

12. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR §1.48(b). Any amendment of

inventorship must be accompanied by a petition under 37 CFR §1.48(b) and by the fee required under 37 CFR §1.17(l).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Terry McKelvey, can be reached on (571)-272-0775 Monday through Friday 8:30 A.M. to 5:00 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (i.e., PAIR) system. Status information for the published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (i.e., EBC) at: (866)-217-9197 (toll-free). Alternatively, status inquiries should be directed to the receptionist whose telephone number is (703) 308-0196.

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(571) 272-0923



RALPH GITOMER  
PRIMARY EXAMINER  
GROUP 1200

August 21, 2006